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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,992	09/02/2003	John E. Hutchins	BSX-214.1CON	1427
7590	03/29/2007		EXAMINER	
Steven M. War Fulbright & Jaworski L.L.P. 801 Pennsylvania Avenue, N.W. Washington, DC 20004-2623			WOO, JULIAN W	
			ART UNIT	PAPER NUMBER
			3731	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/29/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/651,992	HUTCHINS ET AL.	
Examiner	Art Unit		
Julian W. Woo	3731		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 March 2007.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 7,8,10-12 and 15-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 7,8,10-12 and 15-19 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. The finality of the Office action of January 8, 2007 is hereby withdrawn.

***Terminal Disclaimer***

2. The terminal disclaimer filed on October 25, 2006 was mistakenly accepted in the Office action of January 8, 2007. The acceptance of the terminal disclaimer disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,676,659 is hereby withdrawn, because an attorney or agent, not of record, signed the terminal disclaimer. Applicant is reminded that an attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

***Claim Objections***

3. Claim 15 is objected to because of an informality, which can be corrected as follows: In line 4, "handler" should be replaced by --handle--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. With respect to base claim 15: It is not certain whether the "device" is a part of the "catheter handle," since the "handle clamping member" is only said to be "configured to affix a proximal end of [the] device to said catheter handle," (i.e., the device and catheter handle are not necessarily connected); yet the device is said to extend through a lumen of a catheter and is affixed to the catheter, which is said to be connected to the catheter handle, which in turn, is said to cause rotation of a proximal end of the device. In short, it is not certain what limitations comprise the "catheter handle" itself and what comprises elements connected to the handle. To point out and distinctly claim the subject matter which the Applicant regards as the invention, the Examiner suggests that claims 15-19 be amended to claim —A catheter handle *assembly*— (emphasis mine) with positive recitation of limitations including, *inter alia*, —a catheter handle--, -- a rotatable coupling--, --a catheter--, --a handle clamping member--, and --a device--.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 7, 8, 11, 12, 15, 18, and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 6,676,659. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim a method of cutting tissue in a body passage and a catheter handle, where the method includes, *inter alia*, selecting a catheter having first and second lumens, actuating an electrosurgical wire in the second lumen, orientating and rotating the electrosurgical cutting wire by rotating a handle relative to a proximal end of the catheter, and indicating an amount of rotation via a visual indication; and where the catheter handle includes a rotatable coupling configured to allow free rotation of a proximal end of a catheter, a clamping member configured to engage a proximal end of a device extending through a lumen of a catheter, where the device includes a cutting wire, and where the handle includes a rotation indicator that is a visual indicator.

8. Claim 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,676,659 in view of Avitall (5,327,905). Claim 7 of U.S. Patent No. 6,676,659 discloses the invention as recited in claim 10 of the present application, but does not disclose that rotation of handle relative to the proximal end of the catheter is inhibited by a rotation lock. Avitall teaches, at least in figures 1 and 4 and in col. 6, line 68 to col. 7, line 19, rotation of a

handle (70) relative to the proximal end of a catheter (32), where the rotation is inhibited by a rotation lock (80, 84, 85). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to include a rotation lock in the method disclosed in U.S. Patent No. 6,676,659. Such a lock would allow precise, incremental rotation of the distal portion of the catheter.

***Response to Amendment***

9. Applicant's arguments with respect to the rejection of claims 15-19 based on 35 USC 112 have been considered but are not persuasive: See the restated ground(s) of rejection above. The reported allowance of claims 7, 8, and 10-12 is hereby withdrawn in view of the new grounds of rejection above.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3731

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian W. Woo  
Primary Examiner

March 28, 2007